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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/416,985

10/12/1999

TETSUO MORITA

JAO-38013A-R

6854

25944

7590

09/02/2005

OLIFF & BERRIDGE, PLC

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EXAMINER

IZAGUIRRE, ISMAEL

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Tate*

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/416,985	MORITA ET AL.	
	Examiner	Art Unit	
	Ismael Izaguirre	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/668,471.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/12/1999</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION- REISSUE**

### ***Reminder***

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,701,831 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

## **SPECIFICATION**

### ***Abstract***

The abstract of the disclosure is objected to because of its length. An Abstract should be limited to no more than 150. Correction is required. See MPEP § 608.01(b).

## **DECLARATION**

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: applicants identify a specific error regarding claim 1 (08/668,471), and recite specific terms within claim 1 which unduly limit the scope of protection afforded the invention, however, no change (or amendment) is presented for "correcting" claim 1 or "correcting" any of the patented

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claims (patent 5,701,831) and no "newly presented" claim is added which "corrects" the noted error of claim 1 or any of the patented claims. This is confusing. The application "08/668,471 or pat. 5,701,831" is a CIP of "08/605,794 or pat. 5,640,496". The reissue includes intact originally patented claims 1-22 (of 08/668,471) and newly added claims 23-33, which concern apparatus structure of "08/605,794". Perhaps applicants meant to note a specific error in the declaration concerning 08/605,794 instead of the noted error of claim 1 in 08/668,471.

### ***CLAIMS***

#### ***Summary***

Claims 1,6,14,22,23,32 and 33 are the independent claims under consideration in this Office Action.

Claims 2-5,7-13,15-21 and 24-31 are the dependent claims under consideration in this Office Action.

#### ***Claim Rejections***

Claims 1-33 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

#### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,5-8 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tajima et al. (5,553,560).

Tajima et al. teach a headgear holder for use with a sewing machine. The headgear holder 140 (figure 24, for example) accommodates a headgear 46A having a sweatband 46A2 (figure 28, for example) which folds inward (inside) or outward (outside) for allowing embroidery to be sewn onto the frontal, annular, and right or left side temporal portions of the headwear. Tajima et al. teach sewing substantially the entire circumferential surface of a work having a curved configuration such as a cylindrical configuration (column 2, lines 20-23).

Tajima et al. Teach the headgear holder as including a main frame member 140 (figure 24, for example) on which the headgear is set such that the sweatband is placed outside onto the main frame member. A pressing member 150 having a flexibility, such a stainless steel plate which conforms to the shape of the main frame (column 12, lines 32-34) and externally presses the headgear set on the main frame. Two fastening devices 143,158 and 144,164 and 160 are provided at about the temporal locations of the headgear between the main frame member and each corresponding end of the pressing member (accommodating the unfolded sweatband) for holding the pressing member onto the main frame member and thus removably affixing the headgear to the main frame member for embroidering thereof. As the fastening devices are latched, the pressing member is moved to clamp the headgear onto the main frame member, when

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they are (switched) unlatched (at 160 and 162) both fastening members 158 and 164 do not apply a clamping force to the headgear and sweatband.

The pressing member 150 includes a slot 152 for inserting the visor 46A1 of the headgear and gripping teeth 155 and 156 are provided at the outline of the slot for allowing the pressing member to grip a portion of the outside folded sweatband and another portion of the headgear immediately next to the visor. The slot accommodates the visor and pressing member presses the area adjacent the visor for allowing embroidery to the headgear.

Claim 14 is rejected under 35 U.S.C. § 102(b) as being anticipated by Golia (4,998,964).

Golia teaches a headgear holder for use with an embroidery sewing machine. The headgear holder 72 (figure 3, for example) accommodates a headgear 40 having an opening for accommodating the head of a user. The headgear allows embroidery to be sewn onto the annular portion of the headwear. Golia teaches the headgear holder as including a main frame member 72 on which the headgear is set such that the annular portion is fitted onto the main frame member. A pressing member 84 is provided which conforms to the shape of the main frame and externally presses the headgear set on the main frame. Two fastening devices 80, 82, 87 (figure 2, for example) are provided at about the temporal locations of the headgear between the main frame member and each corresponding end of the pressing member for holding the pressing member onto the main frame member and thus removably affixing the headgear to the main frame member for embroidering thereof. Each fastening device

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can be separately latched and thus each can be unfastenable from the main frame member, respectively.

Claims 23-25 and 27-30 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shibata (6,257,057).

Shibata teaches a headgear holder supporting apparatus for use in "blocking" (or setting) a headgear and then positioning the set headgear holder at a sewing machine. The headgear holder supporting apparatus comprises a base 56 (figure 1, for example) which is selectively attachable to a support 57, via a clamping device 58e, and a support member B (or 61 in figure 1) which is adjustably attached to the base (figure 14) and for supporting a frame A (or 12) which is insertable into the inner space of the headgear. The frame, which is curved or arc shaped to correspond with the like shape of the support member, is releasably adjustably attached to the supporting member angularly and rotatably via position changes 101, 102, 103 and 62. The headgear is first set or "blocked" onto the frame, which is supported by the headgear holder support, and then after setting, the headgear along with the frame is moved to an embroidery machine headgear support for embroidery of the headgear thereon.

### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tajima et al. '560 in view of Golia '964.

Tajima et al. disclose the invention substantially as claimed. See above for specific explanations of the structural details of this document. Briefly, Tajima et al. teach a headgear holder including a main frame, a pressing member and two fasteners for clamping the headgear onto the main frame using the pressing member. The two fasteners 143,158 and 160,164 are provided at the ends of the pressing member between the main frame and the pressing member. However, Tajima et al. do not suggest each fastener as being selectively unfastenable (removable) from the main frame and pressing member.

Golia teaches a headgear holder including a main frame, a pressing member and two fasteners for clamping the headgear onto the main frame using the pressing member. The two fasteners 80,82,87 are provided at the ends of the pressing member between the main frame and the pressing member and are each unfastenable (removable) from the main frame and pressing member for separating the main frame from the pressing member.

It would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to construct the fasteners of Tajima et al. as including each as being unfastenable in itself for unfastening (separating) the pressing member from the main frame member. Providing such a structure would allow fastening on one fastener and further adjusting the headgear before fastening the other fastener.




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### ***INQUIRIES***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Izaguirre whose telephone number is (571) 272-4987. The examiner can normally be reached on M-F (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ismael Izaguirre  
Primary Examiner  
Art Unit 3765